

ESTTA Tracking number: **ESTTA635959**

Filing date: **10/29/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197504
Party	Plaintiff Omega SA (Omega AG) (Omega Ltd.)
Correspondence Address	JESS M COLLEN COLLEN IP THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562 UNITED STATES ogelber@collenip.com, tgulick@collenip.com, docket@collenip.com
Submission	Opposition/Response to Motion
Filer's Name	Thomas P. Gulick
Filer's e-mail	tgulick@collenip.com, docket@collenip.com, ogelber@collenip.com, kmogavero@collenip.com
Signature	/Thomas P. Gulick/
Date	10/29/2014
Attachments	k655 opp to motion to consolidate.pdf(1199779 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),  
Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: ALPHA PHI OMEGA and design  
Opp. No.: 91197504 (Parent)  
Serial No.: 77950436

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),  
Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: AΦΩ  
Opp. No.: 91197505 (Child)  
Serial No.: 77905236

**OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO CONSOLIDATE  
UNRELATED OPPOSITIONS**

Opposer hereby respectfully submits its Opposition to Applicant's Motion to Consolidate Unrelated Oppositions.

**I. INTRODUCTION**

Applicant's unique request seeks consolidation of two unrelated opposition proceedings solely for the limited purpose of consideration and determination of the pending Motions for Summary Judgment.

Putting aside that Applicant Alpha Phi Omega's requested consolidation finds no support

in U.S. Trademark Trial and Appeal Board case law, consolidation for a single motion serves none of the purposes of consolidation of proceedings. Consolidation is most typically granted in oppositions where there are commonalities between the parties, goods, marks, and stage in the proceedings. None of those commonalities exist in the two proceedings Applicant Alpha Phi Omega seeks to consolidate. The Oppositions involve different parties, different goods, different marks, are at different stages in the proceedings, and at different briefing stages in their respective Motions for Summary Judgment. There will be no additional savings of time, cost, or effort in relation to the briefings. Given the fact that the proceedings involve unrelated Applicants, different marks, different goods and services, different operative facts and the proceedings are at different procedural stages, they should not be consolidated.

Though Applicant's motives are unclear, any attempt to bootstrap two unrelated opposition proceedings for the purpose of curing defects in one opposition by linking it to an unrelated opposition, is not an appropriate purpose. Applicant's Motion for Consolidation also seems to file what in effect would be a re-argument in Support of its Motion for Summary Judgment. (D.E. 58.)

For these reasons, discussed in greater detail below, Applicant's "self-styled" Motion for Consolidation should be denied.

## **II. FACTS**


Applicant Alpha Omega Epsilon, Inc. requests consolidation of Opposition Nos. 91197504 and 91197505 (the "Alpha Phi Oppositions") and Opposition Nos. 91214449, 91214454, 91214452, and 91214453, (the "Epsilon Oppositions"). An examination of the facts in each of these proceedings is therefore necessary and discussed below.

A. Alpha Phi Omega Oppositions

*[Note: The factual history of the Alpha Phi Omega Oppositions is well documented in the Fact Section of Opposer's Motion to Preclude and Compel (D.E. 59, pages 3-9). For the ease of reference and review, Opposer nonetheless provides a factual summary. If the Board is sufficiently familiar with the facts, this section can be skimmed until the Fact Section entitled Alpha Omega Epsilon Oppositions.]*

Opposer initiated the instant oppositions against Applicant's U.S. Trademark Registration



Nos. 77950436 (for the mark  for "Jewelry," in Class 14) and 77905236 (for the mark **AΦΩ** for "Headwear; Jackets; Shirts; Sweat shirts," Class 25) on November 22, 2010. Alpha Phi Oppositions, D.E. 1. In support of the Alpha Phi Oppositions, Opposer relied upon the following U.S. Trademark Registration Nos.: 25,036, 566,370, 577,415, 578,041, 660,541, 1,290,661, 1,969,071, 2,912,918, 3,146,117, and 3,318,408. *Id.* at p. 2.

Alpha Phi Omega ("Alpha Phi") filed its Answers in the Alpha Phi Oppositions on December 27, 2010. Alpha Phi Oppositions, D.E. 4. Following a number of consented stipulations for suspension for settlement discussions, the parties moved to consolidate the Alpha Phi Oppositions on February 19, 2013. Alpha Phi Oppositions, D.E. 43. The Board granted the request on March 18, 2013. *See* Alpha Phi Oppositions, D.E. 44.

Opposer served Opposer's First Set of Interrogatories, Opposer's First Request for Production of Documents and Things, and Opposer's First Request for Admissions upon Applicant Alpha Phi on March 27, 2013. Declaration of Oren Gelber ("Gelber Decl.") at ¶ 6. This was followed by Opposer's Second Request for Production of Documents and Things and

Second Request for Admissions on June 17, 2013. *Id.* at. ¶ 7. Following productions by Applicant, Opposer sent multiple deficiency letters on June 13, 2013, November 21, 2013, December 4, 2013, and June 25, 2014 and the parties held multiple meet and confer conferences on July 12, 2013, October 16, 2013, and July 9, 2014. *Id.* at. ¶¶ 8 and 9. Opposer sought Applicant's written assurances that it was not withholding any materials in an effort to avoid the need for a motion to compel. *Id.* at. ¶ 9. Applicant continuously refused Opposer's requests. *Id.*

Applicant filed a Motion to Compel on January 10, 2014. Alpha Phi Oppositions, D.E. 50. On May 31, 2014, the Board granted portions of Applicant's Motion to Compel. *See* D.E. 55. On June 19, 2014, discovery closed. Gelber Decl. at ¶ 10. On June 30, 2014, Opposer filed a Motion for Reconsideration on portions of the Board's May 31, 2014 order on Applicant's Motion to Compel. Alpha Phi Oppositions, D.E. 56. That motion has yet to be decided.

On July 25, 2014, well after the close of discovery and multiple meet and confers to avoid any unfair surprise or prejudice from any delinquent discovery, Applicant produced over 134 pages of supplemental document production (more than Applicant produced during discovery) (hereinafter referred to as the "July 25, 2014 Production"). Gelber Decl. ¶ 12. The July 25, 2014 Production included the Declarations of Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley (hereinafter, "the Declarants"). *Id.* The July 25, 2014 Production was not recently discovered information but information which was known, accessible and available to Applicant much earlier. Applicant withheld responsive documents until this late date in order to prejudice Opposer.<sup>1</sup>

---


<sup>1</sup> This is not the first instance in which Applicant's counsel has employed such a tactic. In the case *Abraham v. Alpha Chi Omega* before the Northern District of Texas Applicant's counsel in these proceedings was among the attorneys defending a group of Greek organizations. In that case, the Greek organizations' counsel attempted to submit third party sworn statements in support of their Motion for Summary Judgment, but following the plaintiffs' objection, the Court refused to consider the Greek organizations' untimely declarations noting the potential prejudice to the plaintiff. *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396, 425-426 (N.D. Tex. 2011).

On July 29, 2014, Opposer filed a Motion to Preclude Unjustifiably Delayed Discovery Production and to Compel Discovery. Alpha Phi Oppositions, D.E. 59. Opposer's Motion seeks an Order to preclude the July 25, 2014 Production from this proceeding due to Applicant's conduct.

Also on July 29, 2014, Applicant Alpha Phi filed a Motion for Summary Judgment (Alpha Phi Oppositions, D.E. 58), incorporating and relying upon the July 25, 2014 Production. In response to Applicant's Motion for Summary Judgment, Opposer filed a Motion for (1) the Board's Consideration of Motion to Preclude and Compel Prior to Considering Summary Judgment Motion; and (2) Suspend Time for Opposer's Opposition to Applicant's Motion for Summary Judgment; or in the Alternative, (3) Motion Under Rule 56(d) to Take Discovery. Alpha Phi Oppositions, D.E. 63.

#### B. Alpha Omega Epsilon Oppositions

On January 13, 2014, Opposer initiated separate opposition proceedings against an entirely different entity by the name of Alpha Omega Epsilon, Inc. ("Epsilon"). Opposition Nos. 91214449, 91214454, 91214452, and 91214453 (the "Epsilon Oppositions"), D.E. 1. The subjects of the Epsilon Oppositions were U.S. Trademark Application Serial Nos. 85855823 (for the mark **AΩE** for "Jewelry," in Class 14 and "Hats; Jackets; Shirts; Sweat pants; Sweat shirts; Sweaters," in Class 25), 85855839 (for the mark ALPHA OMEGA EPSILON for "Hats; Jackets;

Shirts; Sweat pants; Sweat shirts; Sweaters," in Class 25), 85857062 (for the mark  for "Indicating membership in a(n) professional and social collegiate sorority for student and alumna

members,” in Class 200) and 85857065 (for the mark ALPHA OMEGA EPSILON for “Indicating membership in a(n) professional and social collegiate sorority for student and alumna members” in Class 200). In support of the Epsilon Oppositions, Opposer relied upon the following U.S. Trademark Reg. Nos. 25,036, 577,415, 578,041, 566,370, 3318408, and U.S. Application Ser. No. 85877912. *Id.* at p. 2.

Epsilon filed its Answers in the Epsilon Oppositions on February 17, 2014. Epsilon Oppositions, D.E. 4. In accordance with the Trademark Trial and Appeal Board’s Scheduling Order, Discovery in the Epsilon Oppositions opened on March 24, 2014. *See* Epsilon Oppositions, D.E. 2.

The Epsilon Oppositions were consolidated under Opposition No. 91214449 on April 1, 2014, following Opposer’s submission of a Motion for Consolidation of Related Proceedings, with Applicant Epsilon’s consent. Gelber Decl. at ¶ 20 and Epsilon Oppositions, D.E. 6.

Opposer served Epsilon with its First Set of Interrogatories, First Request for Production of Documents and First Request for Admissions on June 2, 2014. Gelber Decl. at ¶ 21. Applicant Epsilon served Opposer with Applicant’s Responses and Objections to Opposer’s First Request for Production of Documents and Things, and Applicant’s Responses and Objections to Opposer’s First Request for Admissions, and Objections to Opposer’s First Set of Interrogatories on July 10, 2014. *Id.* at ¶ 22. On July 21, Epsilon provided document production labeled AOE 0001-0203. *Id.* at 23. Four days later, Epsilon sent Opposer’s counsel multiple emails containing supplemental document production. *Id.* at ¶¶ 12 and 24. The document production provided on July 25, 2014 was produced in both the Alpha Phi Oppositions and the Epsilon Oppositions. *Id.*

In light of the July 25, 2014 production, Opposer sent an email to Epsilon’s counsel to advise of its intent to depose the Declarants on August 28, 2014. Gelber Decl. ¶ 25. Opposer

inquired whether these witnesses would appear willingly. *Id.* Epsilon's counsel did not respond (*Id.*); accordingly, Opposer issued subpoenas for each of the Declarants on September 3, 2014. *Id.* at ¶ 27. (Opposer was able to successfully serve Ms. Wampler, Ms. Miraglia, and Mr. Smiley on September 4 and 5, 2014, but was unable to personally serve Mr. Shaver, as the address provided in his Declaration was a post office box. *Id.*) Opposer also served upon Epsilon's counsel a Notice of Deposition to Applicant pursuant to Rule 30(b)(6) on September 3, 2014. *Id.* at ¶ 26.

On September 8, 2014, Opposer's counsel emailed Applicant's counsel to follow up regarding dates of availability for the deposition of Applicant pursuant to Rule 30(b)(6) and to confer with regard to the subpoenas issued to Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley. *Id.* at ¶ 28. Applicant's counsel responded with an email the same day (September 8, 2014) acknowledging service of the Notice of Deposition and Subpoenas and seeking to discuss dates of availability. *Id.* at ¶ 29. On that same day, Applicant Epsilon filed a Motion for Summary Judgment. Epsilon Oppositions, D.E. 7. In response, Opposer filed a Motion pursuant to Rule 56(d) Seeking Discovery from Applicant. Epsilon Oppositions, D.E. 9.

As is clear from the facts recited above, these two oppositions involve entirely different and unrelated parties. There are different operative facts, different marks and different goods and services at issue. The two actions are at different procedural stages. The respective Applicants have the same lawyer, but that is obviously not a relevant factor. Opposer raised these issues to Applicant's counsel in a letter of October 22, 2014 and noted to Applicant's counsel that case law does not support the limited request for consolidation of the type requested by Applicant, and further serves no legitimate purpose in these proceedings. *See* Gelber Decl. at ¶ 32 and Exhibit 1. Opposer requested the withdrawal of Applicant's Motion for Consolidation (Alpha



Phi Oppositions, D.E. 67). Gelber Decl. at ¶ 33. Applicant's counsel has not responded to Opposer's request. The motion has not been withdrawn, thus necessitating this Opposition.

### III. ARGUMENT

Alpha Phi's request for consolidation of the Alpha Phi Oppositions and Epsilon Oppositions is baseless and is also frivolous. Applicant cites no authority which would substantiate the consolidation of oppositions involving different parties and different marks in a likelihood of confusion case, let alone for the limited purpose of considering and determining a single motion.

As shown below, not only is there a lack of support for this Motion, but to consolidate these proceedings at all would be counterproductive, prejudicial, dilatory, and inconvenient.

Applicant Alpha Phi's Motion to Consolidate should be denied.

#### A. There is No Support for Consolidation for the Purposes of a Single Motion

Applicant cannot point to a single case in support of its request. In all of the cases cited by Applicant to support its Motion, the Trademark Trial and Appeal Board ("Board") consolidated the entire opposition. None of the cases cited by Applicant consolidate proceedings for a "limited purpose" of a single motion.

Specifically, the proceedings consolidated in *World Hockey Association v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *S. Industries v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997); *M.C.I. Foods, Inc. v. Brady Bunte*, 96 USPQ2d 1544 (TTAB 2010); and *Target Brands, Inc. v. Artificer Life Corp.*, 2014 TTAB LEXIS 203 (TTAB May 6, 2014) were all consolidated

for the entire proceeding, not for a single motion. Applicant also cites to *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991) and *New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011) however in both these cases, consolidation was a topic discussed only in dicta and no consolidation order ever issued. There are no reported cases where the Board has consolidated opposition proceedings purely for the purpose of a single motion.

The consolidation Applicant seeks of these proceedings lacks any foundation in precedent and should be denied.

B. The Underlying Purpose of the Consolidation Procedure Would be Frustrated by the Consolidation that Applicant Seeks

The purpose of consolidation is to conserve the time, effort and expense of the parties and of the tribunal. TBMP § 511; *Palmer v. N.Y. State Dep't of Corr.*, 342 Fed. Appx. 654, 656 (2d Cir. 2009). Consolidation of the Alpha Phi and Epsilon Oppositions for the purpose of determining the Motions for Summary Judgment only would not conserve any of these resources.

The two separate proceedings at issue have moved forward independently of each other for a significant portion of time. The separate Opposition actions are at different procedural stages. In the Alpha Phi Oppositions, Opposer's testimony period is opening imminently. *See* Alpha Phi Oppositions, D.E. 41 and 42. The Epsilon Oppositions are still within the discovery period. *See* Epsilon Oppositions, D.E. 2.

There are also different outstanding motions pending in each of these proceedings. The motions are separate to each action. There are four motions pending in the Alpha Phi

Oppositions: (a) Opposer's Motion for Reconsideration (Alpha Phi Oppositions, D.E. 56); (b) Opposer's Motion to Preclude Unjustifiably Delayed Discovery and to Compel (Alpha Phi Oppositions, D.E. 59); (c) Applicant's Motion for Summary Judgment (Alpha Phi Oppositions, D.E. 58); and (d) Opposer's Motion for (1) the Board's Consideration of Motion to Preclude and Compel Prior to Considering Summary Judgment Motion; and (2) Suspend Time for Opposer's Opposition to Applicant's Motion for Summary Judgment; or in the Alternative, (3) Motion Under Rule 56(d) to Take Discovery (Alpha Phi Oppositions, D.E. 63) . In the Epsilon Oppositions, only Applicant's Motion for Summary Judgment (Epsilon Opposition, D.E. 7) and Opposer's Rule 56(d) motion are currently pending. Epsilon Opposition, D.E. 11.

In the Alpha Phi Oppositions, the Motion for Reconsideration would need to be determined first, as it was filed on June 30, 2014. Alpha Phi Oppositions, D.E. 56. Opposer has also requested that its Motion to Preclude Unjustifiably Delayed Discovery and to Compel be determined prior to consideration of Applicant's Motion for Summary Judgment in the Alpha Phi Oppositions. *See* Alpha Phi Oppositions, D.E. 63. As such, the Board is asked to address three separate motions brought by Opposer (the Motion for Reconsideration (Alpha Phi Oppositions, D.E. 56), the Motion to Preclude and Compel (Alpha Phi Oppositions, D.E. 59) and the Motion for Rule 56(d) Discovery (Alpha Phi Oppositions, D.E. 63)) in the Alpha Phi Omega Oppositions, before then reaching Applicant's Consolidation Motion (Alpha Phi Oppositions, D.E. 67) and Applicant's Motion for Summary Judgment (Alpha Phi Oppositions, D.E. 58).

Additionally, the briefing of Opposer's Motion for (1) the Board's Consideration of Motion to Preclude and Compel Prior to Considering Summary Judgment Motion; and (2) Suspend Time for Opposer's Opposition to Applicant's Motion for Summary Judgment; or in the Alternative, (3) Motion Under Rule 56(d) to Take Discovery in the Alpha Phi Oppositions are

complete as of October 14, 2014. *See* Alpha Phi Oppositions, D.E. 63, 65 and 68. In the Epsilon Oppositions, Opposer filed a Motion Under Rule 56(d) to Take Discovery on October 14, 2014. Epsilon Oppositions, D.E. 11. Epsilon has not filed its response to Opposer's Motion and Opposer may file a reply in support of its Rule 56(d) motion.

Each proceeding - the Alpha Phi Oppositions and Epsilon Oppositions- has a different factual record and includes different parties, marks, and goods/services.

The lack of procedural synchronicity and commonality between the matters militates against consolidation of these Oppositions. Consolidation, apart from being without basis, further complicates an already complicated record. No time or effort could ever be saved, especially at this late juncture, to meet the purposes of consolidation. *Blue Cross & Blue Shield Ass'n v. Universal Care, Inc.*, 2000 TTAB LEXIS 103, \*1 (TTAB 2000) (deferring consolidation due to different procedural postures of the proceedings). The underlying purpose of consolidation is not served by consolidating the Alpha Phi and Epsilon Oppositions for summary judgment. Applicant's Motion for Consolidation should be denied.

### C. Lack of Unity Requires the Board to Deny Consolidation

Consolidation typically occurs when there is unity between the parties, marks, goods, and stage in the proceedings. In some instances, one of the unities may be different, provided that other aspects are similar. This point is evidenced by the cases relied upon by Applicant. *World Hockey Association v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975) (same parties; same marks; same procedural stages); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (same parties); *S. Industries v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997) (same parties; same marks); *M.C.I. Foods, Inc. v. Brady Bunte*, 96 USPQ2d 1544 (TTAB

2010) (same parties; same marks; similar procedural stages); and *Target Brands, Inc. v. Artificer Life Corp.*, 2014 TTAB LEXIS 203 (TTAB May 6, 2014) (same parties; same marks; same pleadings; same records; same procedural stages). Applicant seeks to consolidate oppositions where there are no unities among the parties, marks, goods/services or stage in the proceedings, therefore, Applicant's request for consolidation should be denied.



i. *Parties*

While Omega S.A. is the Opposer in both the Alpha Phi and Epsilon Oppositions, the Applicants are different in each of these proceedings. In the Alpha Phi Oppositions, the Applicant is Alpha Phi Omega Service Fraternity. In the Epsilon Oppositions, the Applicant is Alpha Omega Epsilon Inc. The Applicants share only the same attorney of record. Each Applicant has its own separate interests in the individual proceedings. *Pac. Packaging Concepts, Inc. v. X M Int'l, LLC*, 2001 TTAB LEXIS 732, \*4-5 (TTAB 2001) (Board denied a request for consolidation where applicants were different). In all of the cases cited by Applicant, there is no support for the consolidation of cases where the parties were different and the oppositions involved likelihood of confusion. Cases cited in the *New Orleans Louisiana Saints LLC v. Who Dat? Inc.* case involved descriptiveness and genericism claims. See D.E. 11 at page 7 and 99 USPQ2d 1550 (TTAB 2011) citing *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) and *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862 (TTAB 1991).

ii. *Marks*

The marks that are the subject of the Alpha Phi Oppositions differ from the marks that are

the subject of the Epsilon Oppositions.

Alpha Phi's Marks	Epsilon's Marks
	
<b>ΑΦΩ</b>	<b>ΑΩΕ</b>
	ALPHA OMEGA EPSILON

Even in cases involving the same opposer and applicant, the Board has denied consolidation where the marks differ. *See Envirotech Corp. v. Solaron Corp.*, 1981 TTAB LEXIS 21, \*7-8 (TTAB 1981); *see also Gibson Guitar Corp. v. Concordia Inv. Partners, Inc.*, 2009 TTAB LEXIS 442, \* 4-5 (TTAB 2009) (“given the differences in the marks involved in the two proceedings, we have decided it will be clearer to issue two separate opinions”).

### iii. Goods

While the goods and services have some similarities, there are differences.

Alpha Phi's Goods	Epsilon's Goods and Services
Application No. 77950436: Jewelry in Class 14	Application No. 85855823: Jewelry in Class 14; Hats; Jackets; Shirts; Sweat pants; Sweat shirts; Sweaters in Class 25
Application No. 77905236: Headwear; Jackets; Shirts; Sweat shirts in Class 25	Application No. 85855839: Hats; Jackets; Shirts; Sweat pants; Sweat shirts; Sweaters in Class 25
	Application Nos. 85857062 and 85857065: Indicating membership in a(n) professional and social collegiate sorority for student and alumna members in Class 200

iv. *Stage in the Proceedings*

The Oppositions that Applicant seeks to consolidate are at different procedural stages and have varying outstanding motions.

In the Alpha Phi Oppositions, the discovery period is closed and the proceedings are suspended pending disposition of outstanding motions. Upon resumption of the proceedings, Opposer's testimony period will commence immediately; four pending motions require Board determination in the Alpha Phi Oppositions:

- (a) Opposer's Motion for Reconsideration of the Board's May 31, 2014 Order (Alpha Phi Oppositions, D.E. 56);
- (b) Opposer's Motion to Compel Discovery (Alpha Phi Oppositions, D.E. 59);
- (c) Applicant's Motion for Summary Judgment (Alpha Phi Oppositions, D.E. 58); and
- (d) Opposer's Motion: (1) For the Board's Consideration of Motions to Preclude and Compel Prior to Considering Summary Judgment Motion;  
(2) To Suspend Time for Opposer's Opposition To Applicant's Motion for Summary Judgment; or in the alternative,  
(3) Motion Under Rule 56(d) to Take Discovery. (Alpha Phi Oppositions, D.E. 63)

In the Epsilon Oppositions, the discovery period is still open. Before Epsilon filed its Motion for Summary Judgment, Opposer issued and served subpoenas for third party witnesses. Gelber Dec, ¶¶ 26 and 27. Epsilon's counsel claimed to be working on coordinating schedules for dates of availability for witnesses when it filed its Summary Judgment Motion. *Id.* at ¶¶ 28 and 29. The following motions have been filed in the Epsilon Oppositions:

- (a) Applicant's Motion for Summary Judgment (Epsilon Oppositions, D.E. 7)

(b) Opposer's Rule 56(d) Motion to Take Discovery (Epsilon Oppositions, D.E. 11).

The differences in the respective parties, marks, and goods alone are sufficient to justify refusal of consolidation. See *Bellsouth Intellectual Prop. Corp. v. RealTelephony, Inc.*, 2002 TTAB LEXIS 123 (TTAB 2002). Considering that the stage of the proceedings is also drastically different, consolidation should certainly be denied. See *Transparent Language, Inc. v. CyraCom International, Inc.*, 2007 TTAB LEXIS 8 (TTAB 2007); see also *Northstar Marine, Inc. v. Huffman*, 2014 U.S. Dist. LEXIS 116245, \*10 (S.D. Ala. Aug. 21, 2014) (denying consolidation where the cases were at different procedural stages).

D. Opposer Will be Prejudiced By Consolidation

The consolidation of these proceedings prejudices Opposer. It is patently unfair for Applicant to seek consolidation at this late juncture of the Alpha Phi Oppositions especially where the Epsilon Oppositions are not in the same stage of the proceedings. The parties have already been heavily engaged in motion practice in the Alpha Phi Oppositions (much of which has no bearing on the Epsilon Oppositions). Now Alpha Phi and Epsilon seek to consolidate these oppositions. This may require Opposer to seek to defend summary judgment against multiple parties, multiple marks, and multiple goods/services at one time. Such prejudice is unwarranted and defeats the purpose of consolidation.

E. Common Question Of Law And Fact Is Merely One Factor In The Likelihood Of Confusion Analysis

Applicant Alpha Phi asserts that the dispositive factor common to both of the co-pending



Motions for Summary Judgment is the similarity of the marks. Alpha Phi Oppositions, D.E. 67 at p. 5. It is preposterous that Alpha Phi bases its argument to consolidate dispositive motions in two unrelated opposition proceedings on this ground. Alpha Phi ignores the glaring fact that the similarity of the marks is *always* a factor to be considered in the likelihood of confusion analysis. See *Herbko Int'l v. Kappa Books*, 308 F.3d 1156, 1165 (Fed. Cir. 2002). The mere fact that this question arises in both proceedings does not justify consolidation, even for a “limited purpose.” The Applicants are unrelated, the marks and goods are different, the evidentiary records are different, and the oppositions are at two different procedural stages. Alpha Phi’s position is completely without merit.

F. Even if the Request had been Appropriate, the Motion for Consolidation is Untimely

Opposer initiated the Alpha Phi Oppositions on November 22, 2010. Alpha Phi Oppositions, D.E. 1. Alpha Phi filed Answers in each of the respective oppositions on December 27, 2010. Alpha Phi Oppositions, D.E. 4. On February 19, 2013, Opposer filed a Consented Motion to Consolidate the two Alpha Phi Oppositions. Alpha Phi Oppositions, D.E. 43.

Opposer filed the Epsilon Oppositions on January 13, 2014. Epsilon Oppositions, D.E. 1. Epsilon filed Answers in each of the respective oppositions on February 17, 2014. Epsilon Oppositions, D.E. 4. On March 26, 2014, Opposer filed a Consented Motion to Consolidate the four oppositions between Omega and Epsilon. Epsilon Oppositions, D.E. 5.

Applicant already expressly consolidated the two Alpha Phi Oppositions into one proceeding on February 19, 2013 and the four Epsilon Oppositions into one proceeding on March 26, 2014. If it truly believed that consolidation of the Alpha Phi Oppositions and the

Epsilon Oppositions was appropriate, it could have and would have sought Opposer's consent for such consolidation in March 2014, when the four Epsilon Oppositions were consolidated. At this late stage in the Alpha Phi Oppositions, consolidation of two unrelated proceedings for any purpose is untimely.

The facts lead to the unmistakable conclusion that the Applicant is not moving to consolidate at this late juncture for the convenience of the parties or the Board. If Alpha Phi desires consolidation as a means of curing a discovery defect in the Alpha Phi Oppositions, this is not a proper purpose.

Further still, in trying to ascertain what might underlie this seeming aberrant request, Opposer notes that granting this Motion would allow Alpha Phi Omega to exploit customary Board procedures which would usually follow the trial schedule for latest filed opposition. TBMP § 511. ("Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated.") The Epsilon Oppositions are the most recently instituted and thus, consolidation would typically result in the adoption of the trial calendar applicable to those proceedings. Such consolidation could result in the re-opening of discovery in the Alpha Phi Oppositions, where discovery already on June 19, 2014 (Gelber Decl. at ¶ 10), ignoring the absence of any timely filed Motion for such relief.<sup>2</sup>

Even if Alpha Phi should see a benefit to consolidation of its opposition proceedings just as Omega's testimony period is about to begin, time has passed. But with no satisfactory foundation in place, even this reason becomes a nail in the already-sealed coffin.

---

<sup>2</sup> Notably, Applicant Alpha Phi has objected to Opposer's request for Rule 56(d) Discovery, (incorrectly) claiming that it was a Motion to Reopen Discovery and decrying Opposer's alleged attempt to further delay proceedings. *See* Alpha Phi Opposition, D.E. 65. While Applicant has asserted all forms of wild and unsubstantiated accusations regarding Opposer's attempts to delay the proceedings, with this Motion, it is clear that Applicant is the culpable party seeking delay.

G. Applicant is Attempting to Circumvent Defects in One Proceeding through Consolidation with Another Proceeding

As explained fully in Opposer's Motion to Preclude (Alpha Phi Oppositions, D.E. 59), Alpha Phi failed to timely produce evidence during discovery and instead sought to serve evidence and third party declarations on Opposer when Alpha Phi moved for summary judgment just before the beginning of Omega's testimony period. Omega moved to compel discovery and sought to exclude the late produced evidence. Alpha Phi Oppositions, D.E. 59 and 60. Opposer further requested that its Motion to Preclude Unjustifiably Delayed Discovery and to Compel be considered prior to Alpha Phi's Motion for Summary Judgment in its Motion Under Rule 56(d) Seeking Discovery. Alpha Phi Oppositions, D.E. 63.

This same evidence, which was available to Alpha Phi far prior to the end of the discovery period in the Alpha Phi Oppositions, was also produced in the Epsilon Oppositions, but Omega has the opportunity to cross-examine and seek further discovery with regard to the July 25, 2014 production and indeed, Opposer has sought to depose the Declarants and issued subpoenas in this regard. See Gelber Decl. at ¶¶ 26 and 27.

Considered in this context, another motivation by Applicant Alpha Phi's becomes obvious. Alpha Phi knows that the Board could strike a significant portion of its evidence filed in support of its Motion for Summary Judgment.<sup>3</sup> Alpha Phi is hoping to avoid any potential preclusion by consolidating the Alpha Phi and the Epsilon Oppositions for the purpose of determining Summary Judgment. If the Motions for Summary Judgment can be heard together and on the same record, the evidence that was timely filed in the Epsilon Oppositions can also be

---

<sup>3</sup> The Northern District of Texas did just that in *Abraham v. Alpha Chi Omega* when the defendants, a group of Greek organizations, attempted to submit third party sworn statements in support of their Motion for Summary Judgment. The Court refused to consider the Greek organizations' declarations noting the untimeliness of the statements' disclosure and plaintiff's inability to cross-examine those who made the statements would potentially prejudice the plaintiff. *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396, 425-426 (N.D. Tex. 2011). Counsel for Alpha Phi and Epsilon was the defendants' counsel in the *Abraham* case.

considered in the Alpha Phi Oppositions (where it should be excluded).

The Board should not permit Alpha Phi to make an end run around the discovery rules by consolidating the two unrelated proceedings which lack unity of parties, marks, goods and services, operative facts and procedural position. The Board should deny the Motion to Consolidate.

H. The Motion to Consolidate Should be Rejected as a Mere Re-Argument of its Motion for Summary Judgment

Many of the exact arguments made by Alpha Phi in its Motion for Summary Judgment appear in its Motion to Consolidate. *Cf.* Alpha Phi Oppositions, D.E. 58 at pages 6-7 and 13-14 and Alpha Phi Oppositions, D.E. 67 at pages 3-6. Applicant claims it is seeking consolidation for a limited purpose, but no case cited by Applicant advocates the concept of a limited consolidation. When Oppositions are consolidated, they are consolidated through trial, not consolidated for the limited purpose of a single motion and then, at least based on Applicant's proposal, split back apart. Furthermore, legitimate consolidation requests are filed early in the proceedings in order to conserve the parties' and the Board's time, costs and efforts.

As such, the Motion to Consolidate should be stricken as an improper re-argument of its Motion for Summary Judgment and the Board should further deny consolidation of these unrelated proceedings.

#### IV. CONCLUSION

Consolidation of two unrelated opposition proceedings for the limited purpose of consideration and determination of a single motion is unprecedented. Applicant's requested

consolidation is unsupported by case law and logic.

The circumstances of the Alpha Phi Opposition and Epsilon Oppositions do not in any way lend themselves to consolidation, let alone consolidation for the so-called "limited purpose" of deciding a single motion. Consolidation of these Oppositions for the limited purpose of the pending Motions for Summary Judgment, would undermine the purpose of consolidation - to save time, cost and effort.

Typically consolidation is granted in oppositions where there are commonalities between the parties, goods, marks, and stage in the proceedings. None of those commonalities exist in these two proceedings. The oppositions involve different and unrelated parties, different goods, different marks, different operative facts and the proceedings are in different procedural stages.

Even if Applicant's Motion for Consolidation is an attempt to bootstrap two unrelated opposition proceedings, with the purpose of circumventing defects in one opposition by combining it with an unrelated opposition, such motivation does not justify consolidation. By submitting a Motion for Consolidation, Applicant Alpha Phi is also improperly attempt to submit a Surreply. Such a Surreply should be stricken and not considered by the Board.

For these reasons, Opposer respectfully requests that the Board deny Applicant's Motion for Consolidation.

Respectfully submitted,



---

Jess M. Collen  
Thomas P. Gulick  
Oren Gelber  
Collen *IP*  
The Holyoke-Manhattan Building  
80 South Highland Avenue  
Ossining, New York 10562  
(914) 941-5668 Tel.  
(914) 941-6091 Fax  
*Attorneys for Opposer*

Enclosures: Declaration of Oren Gelber

Exhibit 1

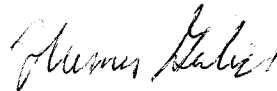
JMC/TPG/OG/KAM:

Dated: October 29, 2014

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

Date: October 29, 2014



---

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),

Opposer,

v.

ALPHA PHI OMEGA,

Applicant.

Mark: ALPHA PHI OMEGA and design

Opp. No.: 91197504 (Parent)

Serial No.: 77950436

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),

Opposer,

v.

ALPHA PHI OMEGA,

Applicant.

Mark: AΦΩ

Opp. No.: 91197505 (Child)

Serial No.: 77905236

**DECLARATION OF OREN GELBER  
IN SUPPORT OF OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO  
CONSOLIDATE UNRELATED OPPOSITIONS**

I, Oren Gelber, declare and state, under penalty of perjury, as follows:

1. I am an attorney at Collen IP, attorneys for Omega S.A. (Omega AG) (Omega Ltd.), ("Opposer") in the above referenced action. The facts set forth in this declaration are personally known to me and I have first hand knowledge thereof. If called as a witness, I could and would competently testify to all the following facts that are within my personal knowledge.

### **Alpha Phi Omega Oppositions**

2. Opposer, Omega SA (Omega AG) (Omega Ltd.), initiated Opposition Nos. 91197504 and 91197505 (the “Alpha Phi Oppositions”) against Applicant Alpha Phi Omega on November 22, 201. Opposition Nos. 91197504 and 91197505, D.E. 1.

3. In support of the Alpha Phi Omega Oppositions, Opposer relied upon the following U.S. Trademark Registration Nos.: 25,036, 566,370, 577,415, 578,041, 660,541, 1,290,661, 1,969,071, 2,912,918, 3,146,117, and 3,318,408. *Id.* at p. 2.

4. Alpha Phi Omega filed its Answers in the Alpha Phi Omega Oppositions on December 27, 2010. D.E. 4.

5. Following a number of consented stipulations for suspension for settlement discussions, the parties moved to consolidate the Alpha Phi Omega Oppositions on February 19, 2013. D.E. 43. The Board granted the request on March 18, 2013. *See* D.E. 44.

6. Opposer served Opposer’s First Set of Interrogatories, Opposer’s First Request for Production of Documents and Things, and Opposer’s First Request for Admissions upon Applicant Alpha Phi Omega on March 27, 2013.

7. Opposer served Opposer’s Second Request for Production of Documents and Things and Second Request for Admissions upon Applicant Alpha Phi Omega on June 17, 2013.

8. Following productions by Applicant, Opposer sent deficiency letters to Applicant on June 13, 2013, November 21, 2013, December 4, 2013, and June 25, 2014.

9. Opposer and Alpha Phi Omega held meet and confer conferences on July 12, 2013, October 16, 2013, and July 9, 2014. During these conferences, Opposer sought Applicant’s written assurances that it was not withholding any materials in an effort to avoid the need for a motion to compel. Applicant refused to provide such assurances.



10. On June 19, 2014, discovery closed.

11. On June 30, 2014, Opposer filed a Motion for Reconsideration on portions of the Board's May 31, 2014 order on Applicant's Motion to Compel. That motion has yet to be decided.

12. On July 25, 2014, Applicant produced over 134 pages of supplemental document production (hereinafter referred to as the "July 25, 2014 Production"). The July 25, 2014 Production included the Declarations of Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley (hereinafter, "the Declarants").

13. On July 29, 2014, Opposer filed a Motion to Preclude Unjustifiably Delayed Discovery Production and to Compel Discovery. D.E. 59. Opposer's Motion seeks an Order to preclude the July 25, 2014 Production from this proceeding due to Applicant's conduct.

14. Also on July 29, 2014, Applicant Alpha Phi Omega filed a Motion for Summary Judgment (D.E. 58), incorporating and relying upon the July 25, 2014 Production.

15. In response to Applicant's Motion for Summary Judgment, Opposer filed a Motion for (1) the Board's Consideration of Motion to Preclude and Compel Prior to Considering Summary Judgment Motion; and (2) Suspend Time for Opposer's Opposition to Applicant's Motion for Summary Judgment; or in the Alternative, (3) Motion Under Rule 56(d) to Take Discovery. D.E. 63.

#### **Alpha Omega Epsilon Oppositions**

16. On January 13, 2014, Opposer initiated separate opposition proceedings against Alpha Omega Epsilon, Inc. Opposition Nos. 91214449, 91214454, 91214452, and 91214453, D.E. 1 (the "Epsilon Oppositions").

17. In support of the Epsilon Oppositions, Opposer relied upon the following U.S. Trademark Reg. Nos. 25,036, 577,415, 578,041, 566,370, 3318408, and U.S. Application Ser. No. 85877912. *Id.* at p. 2.

18. Epsilon filed its Answers in the Epsilon Oppositions on February 17, 2014. Opposition Nos. 91214449, 91214454, 91214452, and 91214453, D.E. 4.

19. In accordance with the Trademark Trial and Appeal Board's Scheduling Order, Discovery in the Epsilon Oppositions opened on March 24, 2014. *See* Opposition Nos. 91214449, 91214454, 91214452, and 91214453, D.E. 2.

20. The Epsilon Oppositions were consolidated under Opposition No. 91214449 on April 1, 2014, following Opposer's submission of a Motion for Consolidation of Related Proceedings, with Applicant's consent. Opposition Nos. 91214449, 91214454, 91214452, and 91214453, D.E. 6.

21. Opposer served Epsilon with its First Set of Interrogatories, First Request for Production of Documents and First Request for Admissions on June 2, 2014.

22. Applicant Alpha Omega Epsilon served Opposer with Applicant's Responses and Objections to Opposer's First Request for Production of Documents and Things, and Applicant's Responses and Objections to Opposer's First Request for Admissions and Objections to Opposer's First Set of Interrogatories on July 10, 2014.

23. On July 21, Epsilon provided document production labeled AOE 0001-0203.

24. Four days later, Applicant sent Opposer's counsel multiple emails containing supplemental document production—the July 25, 2014 Production. The July 25, 2014 Production was produced in both the Alpha Phi Oppositions and the Epsilon Oppositions.

25. On August 28, 2014, Opposer sent an email to Epsilon's counsel to advise of its intent to depose the Declarants, Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley. Opposer inquired whether these witnesses would appear willingly. Epsilon's counsel did not respond.

26. On September 3, 2014, Opposer o served upon Epsilon's counsel a Notice of Deposition to Applicant pursuant to Rule 30(b)(6).

27. Opposer issued subpoenas for each of the Declarants on September 3, 2014. Opposer was able to successfully serve Ms. Wampler, Ms. Miraglia, and Mr. Smiley on September 4 and 5, 2014, but was unable to personally serve Mr. Shaver, as the address provided in his Declaration was a post office box.

28. On September 8, 2014, Opposer's counsel emailed Applicant's counsel to follow up regarding dates of availability for the deposition of Applicant pursuant to Rule 30(b)(6) and to confer with regard to the subpoenas issued to the Declarants.

29. Applicant's counsel responded with an email the same day (September 8, 2014) acknowledging service of the Notice of Deposition and Subpoenas and seeking to discuss dates of availability.

30. Also on September 8, 2014, Applicant Epsilon filed a Motion for Summary Judgment. D.E. 7.

31. In response, Opposer filed a Motion pursuant to Rule 56(d) Seeking Discovery from Applicant. D.E. 9.

**Opposer's Request for Withdrawal of Motions for Consolidation**

32. On October 22, 2014, Opposer sent a letter to Applicant's counsel seeking withdrawal of the Motions for Consolidation. Opposer noted that the Alpha Phi Oppositions and Epsilon Oppositions are at different procedural stages, involve different parties, different operative facts, different marks and different goods and services. Opposer further noted to Applicant's counsel that case law does not support the limited request for consolidation and that consolidation of the type requested by Applicant serves no legitimate purpose in these proceedings. A true and correct copy of Opposer's October 22, 2014 Letter to Applicant's Counsel is attached hereto as Exhibit 1.

33. Applicant's counsel has not responded to Opposer's October 22, 2014 letter and has not withdrawn the Motions for Consolidation, as requested.

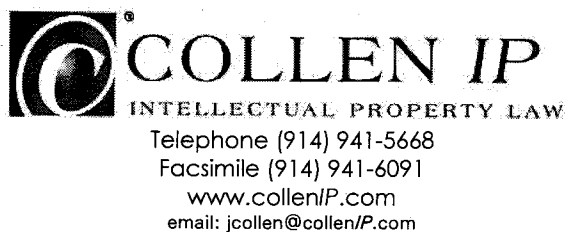
I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed October 29, 2014 at Ossining, New York.

Oren Gelber

Oren Gelber

# **EXHIBIT 1**



October 22, 2014

**BY E-MAIL TO: JWheat@stites.com**

Stites & Harbison PLLC

400 W Market Street, Suite 1800

Louisville, KY 40202-3352

Attention: Jack A. Wheat, Esq.

RE: U.S. Trademark Oppositions 91197505; 91197504  
*Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*  
Adverse Applicant : Alpha Phi Omega  
Adverse Marks : ΑΦΩ; ALPHA PHI OMEGA & design  
Adverse Serial Nos. : 77/905,236; 77/950,436  
Our Refs. : K654; K655

RE: U.S. Trademark Opposition No. 91214449 (Consolidated)  
Adverse Applicant : Alpha Omega Epsilon, Inc.  
Adverse Marks : ΑΩΕ; ALPHA OMEGA EPSILON; ALPHA  
OMEGA EPSILON & Design  
Adverse Serial Nos. : 85/855,823; 85/855,839; 85/857,062;  
85/857,065  
Our Refs. : P890; P891; P892; P893

Dear Jack:

We write regarding the filing of Alpha Phi Omega's and Alpha Omega Epsilon, Inc.'s Motions to Consolidate. We write to respectfully request that you withdraw these Motions.

The two oppositions, which you seek to consolidate solely for the purpose of the Motion for Summary Judgment, involve different marks, different goods, different parties, different operative facts and are at different procedural stages. None of the cases cited in your motion support the unprecedented relief which you seek. Furthermore, none of the cases cited to were consolidated for the limited purposes of a single motion. Such efforts to consolidate make little sense especially after briefing on the Motion for Summary Judgment is complete in one of the proceedings and incomplete in the other.

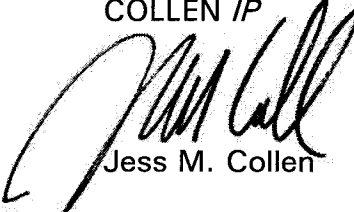


Jack Wheat  
October 22, 2014 – K654; P890  
Page 2 of 2

The Motions To Consolidate you have filed serve no legitimate purpose and will only result in wasting the Board's and the parties' time and resources.

We therefore request that you immediately file a request to withdraw these Motions to Consolidate. We reserve all rights to proceed should you decline our request.

Very truly yours,  
COLLEN /P



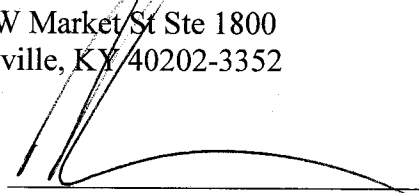
Jess M. Collen

JMC/TPG/OG:ceb

**CERTIFICATE OF SERVICE**

I, Peter Mulhern, hereby certify that a copy of the foregoing Opposer's Opposition to Applicant's Motion for Consolidation was served by First Class U.S. Mail, postage prepaid on this 29th Day of October, 2014 upon

Jack A. Wheat  
Stites & Harbison PLLC  
400 W Market St Ste 1800  
Louisville, KY 40202-3352

A handwritten signature in black ink, appearing to read "Jack A. Wheat", is written over a horizontal line.